

REMARKS

This is a response to the Office Action dated June 16, 2004. Claims 1-5 are pending in the application and stand rejected.

Summary of Examiner's Action and Response

The specification was objected to on the grounds that the abstract contains more than 150 words and that there was no "Brief Description" of FIG. 6. The specification has been amended to satisfy these objections.

The Examiner rejected Claims 1-3 under 35 U.S.C. §103(a) as being unpatentable over Applicant's Disclosure of page 2, lines 6-16 and figure 4 in view of Rieber (U.S. 6,081,925) and DeCaro (U.S. 6,240,560). The Applicant has reviewed these prior art references, and the rejection is respectfully traversed.

The Examiner rejected Claims 4-5 under 35 U.S.C. § 102 as being anticipated by DeCaro. Claim 4 has been amended, and the Applicant believes that the claims should now be allowed.

Response to Rejection of Claims 1-3 under 35 U.S.C §103

The Examiner rejected Claims 1-3 under 35 U.S.C. §103(a) as being unpatentable over Applicant's Disclosure of page 2, lines 6-16 and figure 4 in view of Rieber (U.S. 6,081,925) and DeCaro (U.S. 6,240,560). The Applicant respectfully submits that application of section 103 is improper in this case.

It is axiomatic that the prior art to be considered under section 103 must be analyzed in the absence of any teaching from the claimed invention. Such an evaluation requires the often difficult task

of excluding anything taught or suggested by the present invention from one's mind. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861 (Fed.Cir.1985).

In the abstract, this proposition is straightforward. However, courts have often struggled in applying it to relatively simple inventions. This is true because a relatively simple invention - once revealed by its creator - is easily understood. Thereafter, one is prone "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed.Cir. 983).

The United States Court of Appeals for the Federal Circuit recently discussed this issue in the case of *In Re Dembiczak*, 175 F.3d 994 (Fed.Cir. 2000), *limited on other grounds by In Re Gartside*, 203 F.3d 1305 (Fed.Cir.2000). *Dembiczak* involved a patent claim on the now-familiar orange trash bags with the printed Jack-O-Lantern faces.

The Dembiczak patent application was rejected by the U.S.P.T.O., then rejected by the Board of Patent Appeals and Interferences. In reversing these decisions, the Federal Circuit noted that "[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Id.* at 999.

The evidence of a suggestion, teaching, or motivation to combine prior art references must be established in order to set forth a prima facie case of obviousness. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed.Cir.1985). This evidence must come from the prior art references themselves, the knowledge of one who is skilled in the art, or from the suggestions inherent in the nature of a problem to be solved. *ProMold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed.Cir.1996). The suggestion of combination generally comes from the teachings within

the references themselves. *In Re Rouffet*, 149 F.3d 1350, 1359 (Fed.Cir.1998).

The Applicant respectfully submits that the requirements for a prima facie case of obviousness have not been established in this case. Instead, the Applicant suggests that the P.T.O has fallen into the trap the *Dembiczak* opinion warns so sternly against - that of using the inventor's own disclosure to suggest combinations in order to defeat patentability. With the cited authority in mind, the application of section 103 to the various claims will now be discussed in detail.

The Applicant has reviewed the patent to Reiber and the patent to DeCaro, along with all other prior art of which the Applicant is aware and can find no "teaching or motivation to combine prior art references." Specifically, there is no teaching in the prior art that suggests using the method steps, provided in Claim 1, subsection c and subsection d, of "looping said tee wrap around said first loop formed by said lower portion of said tee shirt to form a second loop lying outside said first loop; and fastening said second fastener to said first fastener, so that said tee wrap binds said first loop formed by said lower portion of said tee shirt to said center web of said bra." Simply stated, there is no suggestion in the prior art that one could or that it would be desirable to wrap a tee wrap through the neck opening and lower portion of the tee shirt thereby attaching the shirt to the center web of the bra. A prior art reference does not create a case of prima facie obviousness if it fails to disclose a material element or limitation claimed in the present invention. *In re Evanega*, 829 F.2d 1110 (Fed. Cir. 1987). Because the prior art does not disclose the limitations as recited in Claim 1, subsection c and subsection d, Applicant respectfully submits that the rejection should be withdrawn and the claim allowed. Claims 2 and 3 should likewise be allowed as they directly depend on Claim 1.

Response to Rejection of Claims 4-5 under 35 U.S.C. §102(b)

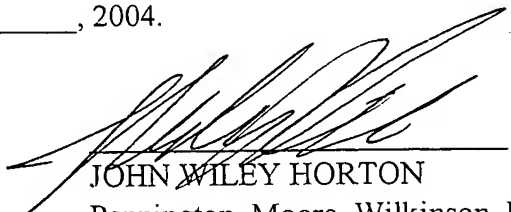
The Examiner rejected Claims 4 and 5 under 35 U.S.C. § 102(b) as being anticipated by DeCaro (U.S. 6,240,560). Applicant has amended Claim 4 and believes that the claims are now in condition for allowance. These amendments add no new matter as the amended claim is fully supported and described in FIG. 6 and in the description, pages 4-5.

In order for a section 102(b) reference to be valid as prior art, every element and limitation of the claimed present invention - as literally defined in the claims - must be disclosed within the piece of prior art. *Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, 225 USPQ 253 (Fed.Cir. 1985); *Atlas Powder Company v. du Pont*, 750 F.2d 1569 (Fed.Cir. 1984); *American Hospital Supply v. Travenol Labs*, 745 F.2d 1 (Fed.Cir. 1984). DeCaro does not contain the limitation provided in Claim 4, subsection f, as amended, "wherein said fabric strip wraps under said lower portion of said tee shirt, behind said center web of said bra, and through said neck opening of said tee shirt and said first fastener and said second fastener are fastened together." Claim 5 likewise should be allowed because it depends directly on Claim 4.

Conclusion

In view of the above amendments and remarks, the Applicant believes that the claims are in condition for allowance. Accordingly, the Applicant respectfully requests that the Examiner reconsider the rejections.

Respectfully submitted this 2ND day of SEPT., 2004.



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